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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,820

12/30/2005

Nobuyuki Takakuwa

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YOUNG & THOMPSON
209 Madison Street
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EXAMINER

TEKLE, DANIEL T

ART UNIT

PAPER NUMBER

2621

NOTIFICATION DATE

DELIVERY MODE

05/12/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/562,820	Applicant(s) TAKAKUWA ET AL.	
	Examiner DANIEL TEKLE	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claim 1-9 and 18-21** rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The claim recites, *inter alia*, “A computer readable storage medium having a computer readable program stored thereon that is ...” After close inspection, the Examiner respectfully notes that the disclosure, as a whole, does not specifically identify what may be included as a computer readable storage medium and what is not to be included as a computer readable storage medium.

4. An Examiner is obliged to give claims their broadest reasonable interpretation consistent with the specification during examination. The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal, *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

5. Therefore, given the silence of the disclosure and the broadest reasonable interpretation, the computer readable storage medium of the claim may include

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transitory propagating signals. As a result, the claim pertains to non-statutory subject matter.

6. However, the Examiner respectfully submits a claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. For additional information, please see the Patents’ Official Gazette notice published February 23, 2010 (1351 OG 212).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-21 rejected under 35 U.S.C. 102(e) as being anticipated by Noguchi et al. (US 2005/0031300).

Regarding Claim 1: Noguchi et al. discloses an information recording medium on which there are recorded: content information; and a plurality of button information each

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of which is for defining a button menu which allows an operation as for said content information, for each reproduction capability which is necessary to reproduce said content information (**paragraph 0051 and fig. 2**), each of said plurality of button information comprising in advance by a combination of predetermined button pages which are determined on the basis of said reproduction capability, out of a plurality of button pages each of which can constitute the button menu and whose display can be changed to each other (**paragraph 0113**), at least one of the plurality of button information being selected in accordance with the reproduction capability in performing the operation (**paragraph 0051 and fig. 2**).

Regarding Claim 2: Noguchi et al. discloses an information recording medium according to claim 1, on which there is further recorded attribute information which indicates the reproduction capability, in association with button information (**paragraph 0114**).

Regarding Claim 3: Noguchi et al. discloses an information recording medium according to claim 1, wherein there is further recorded play list information for defining reproduction sequence of said content information by a unit of item, on said information recording medium (**paragraph 0131**), and play list information includes: item information for specifying the item which constitutes content information; and sub item information for specifying said button information corresponding to the item as a sub item (**paragraph 0134-0136 and 0139**).

Regarding Claim 4: Noguchi et al. discloses an information recording medium according to claim 2, wherein content information and said button information are

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multiplexed by a unit of packet, which is a physically accessible unit, and recorded on said information recording medium as an entire stream (**paragraph 0005, 0113-0114**), there is further recorded an object information file for storing correspondence definition information which defines a correspondence relationship between the entire stream and the plurality of packets which are multiplexed, as reproduction control information for controlling reproduction of the entire stream (**paragraph 0134**), and attribute information is included in said object information file (**paragraph 0139**).

Regarding Claim 5: Noguchi et al. discloses an information recording medium according to claim 1, wherein said button information includes a plurality of button pages which can constitute the button menu and whose display can be changed to each other (**paragraph 0113**).

Regarding Claim 6: Noguchi et al. discloses an information recording medium according to claim 5, wherein at least one of the plurality of button pages includes button command information for defining the operation (**paragraph 0051 and fig. 2**).

Regarding Claim 7: Noguchi et al. discloses an information recording medium according to claim 5, wherein at least one of the plurality of button pages includes button control information being associated with at least one button image information which is displayed and outputted as the button menu, and for displaying and outputting the button image information (**Fig. 6a-c**).

Regarding Claim 8: Noguchi et al. discloses an information recording medium according to claim 7, wherein the button control information includes at least one of button image number information which indicates association with the button image

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information, display position information which indicates a display position on the button menu of a button defined by the button image information, and near-by button information which indicates a change in a state of the button caused by the operation (Fig. 6a-c).

Regarding Claim 9: Noguchi et al. discloses an information recording medium according to claim 1, on which there is further recorded reproduction control information for controlling such that the button menu is displayed, with it superimposed on or replaced by one portion of said content information, or is not displayed at all (**paragraph 0146 and 0186**).

Regarding Claim 10-12: Claim 10-12 reject for similar reason to claim 1 as discussed above.

Regarding Claim 13: Noguchi et al. discloses an information reproducing apparatus according to claim 12, wherein said reproducing device pre-loads button information before reproduction of content information (**paragraph 0060-0061**).

Regarding Claim 14: Noguchi et al. discloses an information reproducing apparatus according to claim 12, further comprising a buffer memory for storing the generated button menu (**paragraph 0066**).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/
Examiner, Art Unit 2621

Regarding Claim 15: Claim 15 reject for similar reason to claim 1-2 and 5 as discussed above.

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Regarding Claim 16: Claim 16 reject for similar reason to claim 1, 5 and 7 as discussed above.

Regarding Claim 17: Claim 17 reject for similar reason to claim 1, 5 and 7 as discussed above.

Regarding Claim 18: Claim 18 reject for similar reason to claim 1, 5 and 7 as discussed above.

Regarding Claim 19: Claim 19 reject for similar reason to claim 1, 5 and 7 as discussed above.

Regarding Claim 20: Claim 20 reject for similar reason to claim 1, 5 and 7 as discussed above.

Regarding Claim 21: Claim 21 reject for similar reason to claim 1 as discussed above.